

Application No. 10/024,266
Reply to Office Action of November 30, 2004

Patent
Attorney Docket No. 86052-6

REMARKS / ARGUMENTS

SUMMARY OF THE AMENDMENTS

Independent Claims 1, 16 and 33 have been amended to clarify the terminology used to refer to different types of Information. Support for the claim amendments can be found, *inter alia*, in paragraph [0040] of the application as published.

Dependent claims 2, 4, 5, 9-13, 15, 17, 20, 21, 24-27, 29, 32, 34, 38-41, 43 and 46 have been amended for consistency with the language of amended claims 1, 16 and 33.

It is respectfully submitted that no new matter has been added under the present amendment.

RESPONSE TO CLAIM REJECTIONS UNDER 35 U.S.C. 112

On page 2 of the Office Action, the Examiner has rejected claims 1-46 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

In response, Independent claims 1, 16 and 33 have been amended to clearly indicate that there are two types of information that the user is prompted to provide or specify, namely "information that is associated to the project and related to billing" and "information that is associated to the project but unrelated to billing". In addition, the dependent claims have been amended wherever reference is made to either or both of these two different types of information.

Application No. 10/024,266
Reply to Office Action of November 30, 2004

Patent
Attorney Docket No. 86052-6

The applicant respectfully submits that as a result of the amendment to claims 1, 2, 4, 5, 9-13, 15-17, 20, 21, 24-27, 29, 32-34, 38-41, 43 and 46, claims 1-46 do satisfy the requirements of 35 U.S.C. 112, second paragraph. The Examiner is therefore respectfully requested to withdraw the rejection of claims 1-46.

RESPONSE TO CLAIM REJECTIONS UNDER 35 U.S.C. 102

On page 2 of the Office Action, the Examiner has rejected claims 1, 16 and 33 under 35 U.S.C. 102(b) as being anticipated by Tran '742. The Examiner contends that Tran discloses or inherently teaches all of the limitations of the claims including "information not related to billing-related information (See, for example Figs. 11 and 12)."

The applicant respectfully disagrees. Firstly, it should be mentioned that claims 1, 16 and 33, as clarified by the present amendment, recite two different types of information, namely, "information that is associated to the project and related to billing" and "information that is associated to the project but unrelated to billing". While the distinction should be sufficiently clear to a person skilled in the art, the Examiner is nevertheless referred to the specification for greater clarity. Specifically, information that is unrelated to billing is information that will not be used during the generation of the statement of account, examples of which include information related to business development, project notes and information regarding an order process (see paragraph [0040] in the application as published).

Now, in column 18, lines 61-63, Tran indicates that "In Fig. 12, an attendees field 438 [...] [is] provided to allow the user to enter **travel-related expense information**" (emphasis added). Thus, it is clear that the attendees field 438 is related to billing and, conversely, that the attendees

Application No. 10/024,266
Reply to Office Action of November 30, 2004

Patent
Attorney Docket No. 86052-6

field 438 is *not* "unrelated to billing". The same is true of all the information entered in the system of Tran, i.e., it is related to billing. Thus, it is respectfully submitted that the cited art does not support a contention that the attendees field 438 of Tran corresponds to the claimed "Information that is associated to the project but *unrelated to billing*" (emphasis added).

Since the cited art fails to explicitly disclose or inherently teach at least one of the limitations of claims 1, 16 and 33, it is respectfully submitted that rejection of these claims under 35 U.S.C. 102 is improper. Thus, the Examiner is respectfully submitted to withdraw the rejection of claims 1, 16 and 33.

RESPONSE TO CLAIM REJECTIONS UNDER 35 U.S.C. 103

On page 2 of the Office Action, the Examiner has rejected claims 2-15, 17-32 and 34-46 under 35 U.S.C. as being unpatentable over Tran '742.

The applicant respectfully disagrees. To begin with, claims 2-15, 17-32 and 34-46 depend either directly or indirectly on one of claims 1, 16 and 33 and therefore include all the limitations of the corresponding base claim, including the aforementioned limitation that is missing from Tran. In fact, one should not be surprised that Tran completely and utterly fails to prompt the user to provide "Information associated to the project but unrelated to billing". This is because Tran is exclusively devoted to the production of bills based on electronically logged time and expense information. Simply put, all of the information entered in the system of Tran is related to billing.

On this basis alone, it is respectfully submitted that claims 2-15, 17-32 and 34-46 are in allowable form and the Examiner is respectfully requested to withdraw his rejection of claims 2-15, 17-32 and 34-46. In addition, the Examiner is respectfully requested to consider the additional arguments

Application No. 10/024,266
Reply to Office Action of November 30, 2004

Patent
Attorney Docket No. 86052-6

presented herein below in support of different subsets of the dependent claims.

Claims 2-12, 14-15, 17-24, 28-31, 34-45 [ADDITIONAL REASONS]

The Examiner contends that "it would have been an obvious design choice to one of ordinary skill in the art [...] to have separate, but linked, databases for billing information and unrelated information as is known in the art to separate personal notes from professional information or to provide a means for selective access to information."

The applicant strongly but respectfully disagrees.

Firstly, the Examiner is cautioned against the use of hindsight to conclude that an invention is unpatentable (see, e.g., *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)¹). Secondly, what part of the cited art or in the common general knowledge does the Examiner refer to in support of the above statement²? How can the Examiner suggest that a person who is concerned exclusively with the production of an efficient billing system would modify this system so as to (1) prompt a user to specify information that is NOT related to billing, and then (2) treat this information in an entirely different way by creating a separate message for this information and sending it to a different destination?

The clear answer is that it would not be obvious to do so, and especially not obvious to a reader of Tran. In view of the foregoing additional reason, it is respectfully submitted that a rejection under 35 U.S.C. 103 is improper, and

¹ "The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness."

² For the Examiner to establish a *prima facie* case of obviousness, three criteria must be considered: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all of the claim limitations. MPEP §§ 706.02(j), 2142 (8th ed.).

Application No. 10/024,266
Reply to Office Action of November 30, 2004

Patent
Attorney Docket No. 86052-6

the Examiner is respectfully requested to withdraw the rejection of claims 2-12, 14-15, 17-24, 28-31, 34-45.

Claims 13, 32, 46 [ADDITIONAL REASONS]

The Examiner has not explicitly rejected these claims. However, it is worth noting that business development information, project notes and information relating to an order process are *in no way related to* (and certainly not obvious from) the "attendees information" used to justify an expense report as is done in Tran.

In view of the foregoing additional reason, the Examiner is respectfully requested to withdraw the rejection of claims 13, 32 and 46.

Application No. 10/024,266
Reply to Office Action of November 30, 2004

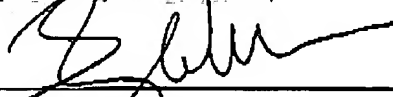
Patent
Attorney Docket No. 86052-6

CONCLUSION

In view of the foregoing, Applicant is of the view that claims 1-46 are in allowable form. Favourable reconsideration is requested. Early allowance of the Application is earnestly solicited.

If the application is not considered to be in full condition for allowance, for any reason, the Applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP 707.07(j) or in making constructive suggestions pursuant to MPEP 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,



Date: February 28, 2005

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